

Remarks

Claims 21-23, 26-28, 31 and 34-37 are pending.

Claim Objections

Claim 28 has been amended to recite the correct dependency.

Rejections Based On Guillemín

Claims 27, 28, 31 and 34-37 were rejected under Section 103 as being obvious over Guillemín (7120605) in view of well known prior art. Guillemín can qualify as prior art only under Section 102(e). Hewlett-Packard Development Company (or its predecessor in interest Hewlett-Packard Company) owned Guillemín and the present Application at the time of the invention, as is evident from the assignments of Guillemín recorded January 26, 2001 (inventors to Hewlett-Packard Co.) and September 30, 2003 (Hewlett-Packard Co. to Hewlett-Packard Development Co.) at reel/frame 011479/0049 and 01461/0492, respectively, and the assignments of this Application recorded April 2, 2001 (inventors to Hewlett-Packard Co.) and September 30, 2003 (Hewlett-Packard Co. to Hewlett-Packard Development Co.) at reel/frame 011708/0679 and 01461/0492, respectively. Pursuant to Section 103(c), therefore, Guillemín does not preclude the patentability of Claims 27, 28, 31 and 34-37.

Rejections Based On The Combination Of Nerlikar And Olsen

Claims 21-23 and 26 were rejected under Section 103 as being obvious over Nerlikar (5629981) in view of Olsen (6952780). The Examiner cites Nerlikar as teaching printing a secured print job using a bio signature. The Examiner acknowledges that Nerlikar does not teach a printer displaying a plurality of pending secured print jobs each having an authorized bio signature associated therewith (recited in Claim 21). The Examiner states that Olsen teaches that a "verified user may then view a document list from a printer interface, col. 10, lines 51-54" and then goes on to conclude that:

"[I]t would have been obvious ... to add the feature of a display of pending documents taught by Olsen et al to the receiving printer of Nerlikar in order to obtain a device capable of showing pending documents. The motivation for doing so would be to select documents that the user intends and is allowed to print." Office Action page 3.

In Olsen, the only print jobs that are displayed are those that the "verified" user is authorized to print. That is to say, the act of verifying that the user is authorized to print a print job has already been completed as a prerequisite to the act of displaying the print job(s). In the method of Claim 21, by contrast, the act of comparing bio signatures is not a prerequisite to the act of displaying the print jobs. In fact, the act of comparing bio signatures in Claim 21 is performed after the act of displaying the print jobs. Hence, adding the display feature of Olsen to the fax printing procedure of Nerlikar does not yield the method of Claim 21. The Examiner's assertion to the contrary is not correct.

This distinction is significant. The method of Claim 21 allows for the printer displaying secured print jobs that are not all associated with the same bio signature. Olsen does not. Furthermore, there is no utility in having a user step up to Nerlikar's fax machine, enter her bio signature to bring up a display of print jobs she is authorized to print as in Olsen, and then, when she has selected from the list, to have her again enter her bio signature as a prerequisite to print what is already known to be an authorized print job. The apparent purpose of Olsen's verification of the list of print jobs is to eliminate the need for a subsequent verification of any individual print job selected from the list. There is just no reason a person skilled in the art would use the display of Olsen in the fax printing procedure of Nerlikar without eliminating either the "pre-listing" verification of Olsen or the "post-selection" verification of Nerlikar.

If the Examiner is inclined to consider changing the grounds of rejection to this two-step combine-then-modify scenario, before doing so he is urged to carefully examine each reference to see if there is objective evidence that motivates both the combination and then the modification to the combination. If the Examiner believes such evidence exists, he is respectfully requested to specifically point out and explain that evidence in the next action as well as cite to the pertinent passages in each reference. So far as Applicant can tell, no such evidence exists.

For all of these reasons, the Examiner has failed to establish a prima facie case of obviousness based on the combination of Nerlikar and Olsen.

The foregoing is believed to be a complete response to the pending Office Action.

Respectfully submitted,
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